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OFFICE OF PETITIONS

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EXPRESS MAIL NO. EV398877331US

PTO/SB/64 (08-03)

Approved for use through 07/31/2006. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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**PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED
UNINTENTIONALLY UNDER 37 CFR 1.137(b)**

Docket Number (Optional)

60117-4

First named inventor: **Margaret E. Black**

Application No.: **09/173,463**

Art Unit: **1652**

Filed: **October 14, 1998**

Examiner: **Christian L. Fronda**

Title: **THYMIDINE KINASE MUTANTS AND FUSION PROTEINS HAVING THYMIDINE KINASE AND
GUANYLATE KINASE ACTIVITIES**

Attention: Office of Petitions

Mail Stop Petition

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

FAX: (703) 308-6916

NOTE: If information or assistance is needed in completing this form, please contact Petitions
Information at (703) 305-9282.

The above-identified application became abandoned for failure to file a timely and proper reply to a
notice or action by the United States Patent and Trademark Office. The date of abandonment is the day after the
expiration date of the period set for reply in the Office notice or action plus any extensions of time
actually obtained.

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION

NOTE: A grantable petition requires the following items:

- (1) Petition fee;
- (2) Reply and/or issue fee;
- (3) Terminal disclaimer with disclaimer fee -- required for all utility and plant applications
filed before June 8, 1995; and for all design applications; and
- (4) Statement that the entire delay was unintentional.

1. Petition fee

☐ Small entity - fee \$ _____ (37 CFR 1.17(m)). Applicant claims small entity status. See 37 CFR 1.27.

☒ Other than small entity - fee **\$1330** (37 CFR 1.17(m))

2. Reply and/or fee

A. The reply and/or fee to the above-noted Office action in
the form of **Response**

(identify type of reply):

- ☐ has been filed previously on _____
- ☒ is enclosed herewith.

B. The issue fee of \$ _____

- ☐ has been paid previously on _____
- ☐ is enclosed herewith.

07/12/2004 SSESHE1 00000008 040258 09173463

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[Page 1 of 2]

This collection of information is required by 37 CFR 1.137. The information is required to obtain or retain a benefit by the public which is to file (or by the
USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14.

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07/12/2004
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Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OM control number.

3. Terminal disclaimer with disclaimer fee

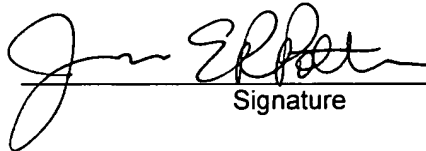
- ☒ Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.
- ☐ A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of \$_____ for a small entity or \$_____ for other than a small entity) disclaiming the required period of time is enclosed herewith (see PTO/SB/63).

4. STATEMENT: The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. [NOTE: The United States Patent and Trademark Office may require additional information if there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137(b) was unintentional (MPEP 711.03(c), subsections (III)(C) and (D))].

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

June 8, 2004

Date



Signature

Telephone
Number:

206-628-7650

Jane E. R. Potter

Typed or printed name

1501 Fourth Avenue, Suite 2600

Address

Seattle, WA 98101

Address

Enclosures: ☒ Fee Payment

☒ Reply

☐ Terminal Disclaimer Form

☒ Additional sheets containing statements establishing unintentional delay

☒ Other: PTO/SB/22 Petition for Extension of Time - 3m

CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR 1.8(a)]

I hereby certify that this correspondence is being:

☒ deposited with the United States Postal Service on the date shown below via Express Mail in an envelope addressed to: Attn: Office of Petitions, Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria VA, 22313-1450.

☐ transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at (703) 308-6916.

July 8, 2004

Date



Signature

Jessica Gaunt

Typed or printed name of person signing certificate

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JUL 08 2004

Interview Summary

Application No.

09/173,463

Applicant(s)

Black

Examiner

Christian L. Fronda

Group Art Unit

1652

All participants (applicant, applicant's representative, PTO personnel):

(1) Christian L. Fronda

(3) _____

(2) James M. Verna

(4) _____

Date of Interview Nov 14, 2001Type: a) ☒ Telephonic b) ☐ Video Conferencec) ☐ Personal (copy is given to 1) ☐ applicant 2) ☐ applicant's representative]Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No. If yes, brief description:Claim(s) discussed: 1-16

Identification of prior art discussed:

NoneAgreement with respect to the claims f) ☐ was reached. g) ☒ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments:

The Finality of the Office Action dated June 15, 2001, has been withdrawn. A new Office Action will be sent:

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

i) ☒ It is not necessary for applicant to provide a separate record of the substance of the interview (if box is checked).

Unless the paragraph above has been checked, THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.



EXPRESS MAIL NO. EV398877331US

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Margaret E. Black
Application No. : 09/173,463
Filed : October 14, 1998
For : THYMIDINE KINASE MUTANTS AND FUSION PROTEINS
HAVING THYMIDINE KINASE AND GUANYLATE KINASE
ACTIVITIES

Examiner : Chistian L. Fronda
Art Unit : 1652
Docket No. : 60117-4
Date : July 8, 2004

Attention: Office of Petitions
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P.O. Box 1450
Alexandria, VA 22313-1450

STATEMENT

On June 15, 2001, the Examiner issued a final Office Action indicating that claims 1-11 were rejected. On November 14, 2001 applicants conducted a telephone interview with Examiner Christian L. Fronda. The Interview Summary, a copy of which is attached as Exhibit 1, states:

The Finality of the Office Action dated June 15, 2001, has been withdrawn. A new Office Action will be sent.

By mid-December (one month later), no Office Action had been received. On December 17, 2001, attorney David Parker conducted a telephone conference with Examiner Fronda, in which Examiner Fronda stated that applicants did not need to reply to the June 15, 2001 Office Action because a new Office Action would be issued shortly.

On February 7, 2003, applicants still had not received the twice-promised new Office Action, and a Status Inquiry was filed. No response to the Status Inquiry was received from the

Patent Office. Applicants made repeated and diligent attempts to learn why no Office Action had been received. A series of telephone communications to the Patent Office and subsequent events are summarized as follows:

1. March 13, 2003: Charlotte Bowers of PTO Customer Service stated that, according to PAIR, no Office Action had been mailed.
2. March 18, 2003: Examiner Fronda informed applicants' representative that a new non-final Action would be mailed with the next two weeks.
3. August 7, 2003: Examiner Fronda stated that when the Status Inquiry was filed by applicants, the file was removed from his office and he would telephone applicants' representative when he had located the file.
4. September 26, 2003: A voice message was left for Examiner Fronda requesting update on Office Action.
5. January 13, 2004: A voice message was left for Examiner Fronda requesting update on Office Action.
6. January 14, 2004: Examiner Fronda stated in a voice message that he had been trying to locate the file and that he would call when he located the file.
7. February 5, 2004: Applicants' representative spoke to Supervisory Examiner Ponnathapura Achutamurthy who stated that he would follow up with Examiner Fronda.
8. June 15, 2004: A Notice of Abandonment was issued, for failure to respond to the Office Action dated June 15, 2001.
9. June 18, 2004: Applicants' new representative left a voice message for Examiner Fronda, who left a return message that he will order the case and look into the status. He indicated that the Notice of Abandonment may have been sent in error.

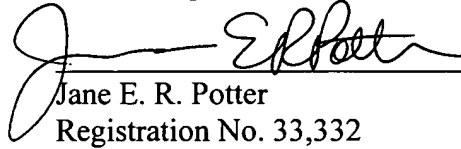
In view of the previous history with this file, applicants are filing the accompanying Petition to Revive. The Petition is filed under the "Unintentional" standard in order to return the application to pending status as soon as possible. As both the Examiner and the SPE have indicated several times over the last 2 ½ years that the finality of the June 15, 2001 Office Action has been withdrawn, and that a new Office Action was being mailed shortly, applicants believe that no response is due in order to return the application to pending status. However, applicants

submit that the "Unavoidable" standard is correct, as the applicants have relied on statements by the PTO and the Examiner, to applicants' detriment.

In summary, the above referenced application was abandoned and prosecution delayed due to action within the Patent Office over which applicants had no control, despite repeated contact and diligence in the investigating the status.

If questions remain regarding this application, the Examiner is invited to contact the undersigned at (206) 628-7650.

Respectfully submitted,
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